

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

September 16, 2003

Cancellation No. 920-41,805

Kymsta Corp.

v.

Quicksilver, Inc.

Peter Cataldo, Interlocutory Attorney

This case now comes before the Board for consideration of respondent's motion to suspend this proceeding pending the determination of a civil action between the parties herein.¹ The motion is fully briefed.² The Board has carefully considered the arguments of both parties with regard to the above motion. However, an exhaustive review of those arguments would only serve to delay the Board's disposition of this matter.

¹ Case No. SACV 02489 DOC, styled *Quicksilver, Inc. v. Kymsta Corp.*, filed on May 22, 2002 in the United States District Court for the Central District of California.

² In addition, respondent has submitted a reply brief which the Board has entertained because it clarifies the issues under consideration herein. Consideration of reply briefs is discretionary on the part of the Board. See Trademark Rule 2.127(a).

Request for Oral Hearing On Motion

As a preliminary matter, it is noted that in its response in opposition to respondent's motion to suspend, petitioner requests a telephonic oral hearing on this motion.

An oral hearing is not held on a motion except by order of the Board. See Trademark Rule 2.127(a). It is the practice of the Board to deny a request for an oral hearing on a motion unless, in the opinion of the Board, an oral hearing is necessary to clarify the issue or issues to be decided. In all but the most extraordinary circumstances, arguments on a motion may be adequately presented in the briefs thereon. Thus, the Board rarely grants a request for an oral hearing on a motion.³ See *Scotch Whiskey Ass'n v. United States Distilled Products Co.*, 18 USPQ2d 1391 (TTAB 1991), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311 (TTAB 1989); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986).

In this case, petitioner's assertions to the contrary notwithstanding, the issues presented in respondent's motion

³ The parties will note the differences between a request for an oral hearing on a motion and a request to resolve the issues raised in a motion in an inter partes proceeding by telephone conference. See Trademark Rules 2.127(a) and 2.120(i)(1). See also TBMP §§502.03 and 502.06 (2d ed. June 2003) and the authorities cited therein.

to suspend are not atypical. Neither are the circumstances giving rise to respondent's filing of its motion so extraordinary that petitioner has been prevented from adequately articulating its objections in its brief in response thereto. Thus, the Board does not find that the current motion to suspend is of such a nature that an exception to the usual practice is warranted. See *Id.*

Accordingly, petitioner's request for an oral hearing on respondent's motion to suspend is denied.

Motion to Suspend

The Board turns then to respondent's motion to suspend this proceeding pending the disposition of a civil action between the parties herein.

With regard thereto, it is well settled that whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule 2.117(a). See also *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. Inc. v. Colita Beverage Company*, 169 USPQ 568 (TTAB 1971).

Suspension of a Board proceeding under such circumstances is solely within the discretion of the Board; the court in which a civil action is pending has no power to suspend proceedings in a case before the Board, nor do parties or their attorneys.⁴ See *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990), and *Martin Beverage*, *supra*.

In this case, the parties to the instant cancellation proceeding and the civil action are the same. Furthermore, in its answer and counterclaim in the civil action, petitioner herein seeks, *inter alia*, the cancellation of respondent's Registration No. 2,427,898, that is, the mark at issue in this cancellation proceeding. In addition, both parties in the civil action seek a determination by the District Court regarding priority of use of their respective marks, including the mark at issue in this cancellation proceeding. Thus, any determination by the Court in the civil action will either be dispositive of, or at least may have a bearing on, the issues before the Board in this

⁴ It should be noted, however, that if the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding, the Board will go forward with its proceeding. See David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984).

cancellation proceeding. Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. *See, for example, Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir.1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986). Finally, petitioner cites no authority to support its contention that the Board must continue the instant cancellation proceeding in order to allow petitioner to obtain discovery for use in the related civil action.

Accordingly, in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, respondent's motion to suspend is hereby **granted; and proceedings herein are suspended** pending final disposition of the civil action involving the parties.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.